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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,025	11/20/2006	Stephen Behr	41313-1004	2195

25213 7590 11/13/2007  
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EXAMINER
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MI, QIUWEN

ART UNIT	PAPER NUMBER
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1655

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11/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/533,025

Applicant(s)

BEHR ET AL.

Examiner

Qiuwen Mi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26 and 30-53 is/are pending in the application.
- 4a) Of the above claim(s) 34 and 36-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26,30-33,35 and 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/26/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION****Election/Restrictions**

Applicant's election with traverse of Group I, species "MMP-9" for claim 26, "stimulate collagen production" for claim 30, and "*Chenopodium quinoa*" for claim 26 in the reply filed on 9/20/07 is acknowledged. The traversal is on the ground that Cyr does not disclose dermatological formulations. This is found persuasive. However, as stated below, since JP 2000336024 teaches cosmetic (dermatological) compositions containing one or more humectant plant extracts of *Chenopodium quinoa* etc. for dry skin, there is no special technical feature in the application. Applicant also argues that searching for all the claims is not a burden. This is not found persuasive because as indicated in the previous Office Action, the inventions of Groups I-II are two distinct inventions for the reason of the record. They have different electronic resources and search queries, and searching for one subject matter will not necessarily lead to another. Applicant is reminded of the extensive literature search in biotechnology which is not co-extensive.

Claims 34, and 36-44 are withdrawn from further consideration as being drawn to nonelected inventions or species.

**Claims Pending**

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Claims 30-53 are newly submitted. Claims 1-25, and 27-29 are cancelled. Claims 26, and 30-53 are pending. Claims 34, and 36-44 are withdrawn as they are directed toward a non-elected invention groups or species. Claims 26, 30-33, 35, and 45-53 are examined on the merits.

### **Abstract Objections**

The Abstract has been objected to, and Applicant is suggested to delete "The present invention provides for" on lines 1, 5, 6, and 8 of the Abstract to be more clear and concise. The first letter of "plant" in lines 1 and 9, and "a" in line 6 should be capitalized after the deletion.

### **Claim Rejections –35 USC § 112, 1st**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48, 49, and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Skin aging or dermatological conditions cannot be prevented. There is no evidence that one would not ever get skin aging by consuming the claimed plant extracts of

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*Chenopodium quinoa*. Unless Applicant can show on the record that skin aging would be completely prevented in every instance, Applicant is requested to cancel the word “preventing”.

Claims 48, 49, and 53 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating skin aging, does not reasonably provide enablement for preventing skin aging. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

It is a common sense that skin aging is inevitable, no matter what plant extracts are being used, the skin of a seventy year old will never look the same as the skin of a one year old. As evidenced by Goihman-Yahr (U, Clinics in Dermatology 14: 153-160, 1996), skin aging is a continuous phenomenon, and it is a result of programmed senescence and prolonged environmental injury to the skin (see the entire article). As mentioned above, the invention only provides the description treating skin aging, and no description prevent skin aging is being disclosed in the specification. It is the opinion of the Examiner, in light of inevitable chronologic skin aging, that Applicant is not enabled for preventing skin aging as instantly claimed. Considering this evidence, the skilled artisan, lacking information with regard to preventing skin aging, would necessarily need to perform tedious trial and error protocols without expectation of success in order to provide for the claimed activity.

*In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970), held that

"Inventor should be allowed to dominate future patentable inventions of others where those inventions were based in some way on his teachings, since such improvements while unobvious from his teachings, are still within his contribution, since improvement was made possible by his work; *however, he must not be permitted to achieve this dominance by claims which are insufficiently supported and, hence, not in compliance with first paragraph of 35 U.S.C. 112*; that paragraph requires that scope of claims must bear a reasonable correlation to scope of enablement provided by specification to persons of ordinary skill in the art; in cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific law; in cases involving unpredictable factors, such as most chemical reactions and physiological activity, scope of enablement varies inversely with degree of unpredictability of factors involved." (Emphasis added)

Due to the large quantity of experimentation necessary to generate the infinite number of variants/fragments recited in the claims and possibly screen same for activity and the lack of guidance/direction provided in the instant specification, this is merely an invitation to the skilled artisan to use the current invention as a starting point for further experimentation. Thus, undue experimentation would be required for a skilled artisan to make and/or use the claimed invention commensurate in scope with the claims.

**Claim Rejections –35 USC § 112, 2<sup>nd</sup>**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30, 47, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 30, Applicant is required to spell out the abbreviation UV in line 3.

Claim 47 recites the limitation "the skin in a subject" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Although claim 51 is not specifically recited for containing indefinite matter, because these claims are dependant upon claim 47, claim 51 necessarily comprise all of the limitations of claim 47. Because claim 51 do not remedy the indefiniteness of claim 47, these claims are also properly rejected under this statute.

**Claim Rejections –35 USC § 102/103**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 30-33, 35, and 45-53 are rejected under 35 USC § 102 (b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2000336024A (N) (see Abstract and full translation).

JP 2000336024 A teaches cosmetic (dermatological) compositions containing one or more humectant plant extracts of *Chenopodium quinoa* etc for dry skin (see Abstract). JP 2000336024A teaches a sample preparation of lotion (thus topical, administering to a subject) comprising purified water (physiologically acceptable carrier), polyethylene glycol 1000 (moisturizing agent), and Quinoa (the same as *Chenopodium quinoa*, see page 4, [0008]) in 20% EtOH extract (solvent extraction) (alcoholic solvent) (see full translation, page 27, [0085]). JP 2000336024 also teaches that composition of cosmetics that contain moisture-retaining plant extracts with sustained moisture-retention effects over extended periods, and possess properties effective for skin treatments that prevent, alleviate, or improve such conditions as dryness, rough skin, cracks, chaps, dandruff, pruritus and inflammatory diseases (maintain and/or improve the health and/or appearance of the skin in a subject) (see page 32, [0100]). JP 2000336024 further teaches Quinoa extract in 30% PG (propylene glycol, see page 24, [0074]) in test solutions (see page 26, Table 2).



The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as inhibiting the activity of matrix metalloprotease-9 (MMP-9) or increasing collagen production. It is deemed that the composition disclosed by JP 2000336024A is not precluded for carrying out the intended function of the claims because the referenced composition comprises the one and the same ingredient disclosed by Applicant as having the claim-designated functions.

Consequently, the claimed method and composition appears to be anticipated by the references, although the reference does not explicitly teach that plant extracts of *Chenopodium quinoa* inhibit the activity of matrix metalloprotease-9 (MMP-9) or increase collagen production.

In the alternative, even if the claimed invention is not identical to the referenced composition/method with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced method is likely to inherently possess the same characteristics of the claimed method composition particularly in view of the similar characteristics which they have been shown to share. Since the cited reference teaches the claimed plant extract (*Chenopodium quinoa*) with the claimed properties, namely, effective for skin treatments that prevent, alleviate, or improve such conditions as dryness, rough skin, cracks, chaps, dandruff, pruritus and inflammatory diseases, it is deemed that inhibiting the activity of matrix metalloprotease-9 (MMP-9) or increase collagen production is the intrinsic mechanism/pathway of the claimed plant extract. Thus, the claimed method would have been obvious to those of ordinary skill in the art with the meaning of U.S.C. 103.

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It would have been *prima facie* obvious to one practicing the invention to use the composition taught by JP 2000336024A to provide a method for maintaining and/or improving the health and/or appearance of the skin, attenuating or reducing the risk of skin aging, or dermatological condition.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

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**Conclusion**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi

  
MICHELE FLOOD  
PRIMARY EXAMINER